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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,027	11/12/2003	Shibo Jiang	#706-A-US	6196

7590

07/05/2006

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EXAMINER

POWERS, FIONA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,027

Applicant(s)

JIANG ET AL.

Examiner

Fiona T. Powers

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 to 25, 27, 28 and 30 is/are rejected.
- 7) ☒ Claim(s) 26 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/12/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/22/03, 7/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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Receipt is acknowledged of the information disclosure statements filed December 22, 2003 and July 26, 2004, which have been entered in the file.

Applicant's election with traverse of Group II, claims 3 to 30 in the reply filed on April 26, 2006 is acknowledged. The traversal is on the ground(s) that Groups I and II are connected by a single relationship and the Examiner would not be seriously burdened by searching and examining the claims of these groups in a single application. This is not found persuasive for the reasons given in the last office action.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1 and 2 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 26, 2006.

Claims 3, 6 and 28 are objected to because of the following informalities: in claims 3 and 6 "Wherein" should be -wherein-. In claim 28, "thereof" should be inserted after "salt". Appropriate correction is required.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 to 6, 22, 24, 28 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, "X" is not defined.

In claims 3 to 5, variables R_1 to R_8 are not defined.

Claims 6, 22, 24, 28 and 30 refer to formula I but this formula does not appear in these claims. To overcome this rejection these claims should be made dependent on claim 3.

In claims 3, 6, 22, 24, 28 and 30 the phrases "having formula I" and "with formula I" render the claims indefinite because these phrases are open ended. It is not clear what else can be included in the compounds. To overcome this rejection these phrases should be replaced by "of the formula I".

The compounds of claim 5 as claimed where X is either O or S are not possible. There are no five-membered heterocyclic rings known that contain one nitrogen and four atoms of either O or S and there are no six-membered heterocyclic rings known that contain one carbon and five atoms of either O or S.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 6 to 25, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarett et al. (Chemical Abstracts, 81:63478, 1974), cited.

The reference discloses the claimed compounds and pharmaceutical compositions where X is C and R₁ to R₈ are selected from H, COOH, OH, Cl and OR where R is alkyl. Note the abstract and Registry Numbers 53242-70-9, 53242-68-5 and 53242-72-1. The compound of claim 27 is Registry Number 53242-68-5.

Claims 3, 4, 6 to 25 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al. (Journal of Medicinal Chemistry, 21(11), 1100-1104, 1978), cited.

The reference discloses the claimed compounds and pharmaceutical compositions where X is C or N and R₁ to R₈ are selected from H, COOH and OH. Note Compound Nos. 4, 5, 7 and 10 to 12 of Table I on page 1101.

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Claims 3 and 6 to 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogassy et al. (J. Chem. Soc., Perkin Transactions 1, 9, 1039-1043, 2001.

The reference discloses the claimed compounds where X is C and R₁ to R₈ are selected from H, COOH, Br, Cl and OR where R is alkyl. Note Compound Nos. 7, 8, 12 to 17 and 21 to 29. The compound of claim 27 is Compound No. 24.

Claims 3, 4 and 6 to 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Rault et al. (US 5627203) or Lang et al. (US 5665739) or Kuno et al. (US 5824691), cited.

The references disclose the claimed compounds where X is C or N and R₁ to R₈ are selected from H, COOH, Cl, alkyl, CN, COOR where R is alkyl and NH₂. Note Preparation Nos. 22, 24, 26 and 27 in columns 15, 16, 17 and 18 of Rault et al.; Examples 11 to 13 in column 11 of Lang et al.; and Compounds 1 to 3 in column 39, Preparation 56 in column 42 and Preparation Nos. 90, 91 and 92 in columns 53 and 54 of Kuno et al.

Claims 26 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The references made of record and not relied upon show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fiona T. Powers
Fiona T. Powers
Primary Examiner

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June 29, 2006